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Filing date: **05/20/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214779
Party	Plaintiff Combe Incorporated
Correspondence Address	ROBERT R CALIRI OLSON & CEPURITIS LTD 20 NORTH WACKER DRIVE, 36TH FLOOR CHICAGO, IL 60606 UNITED STATES rcaliri@olsonip.com, adigman@olsonip.com, docket@olsonip.com
Submission	Opposition/Response to Motion
Filer's Name	Robert R. Caliri
Filer's e-mail	rcaliri@olsonip.com, adigman@olsonip.com, docket@olsonip.com
Signature	/Robert R. Caliri/
Date	05/20/2014
Attachments	Combe-Marke-VAGISERT-002a-oppositiondefault.pdf(22071 bytes) EX.A.pdf(67119 bytes) EX.B-1.pdf(47810 bytes) Ex.C.pdf(26694 bytes) Ex. D-1.pdf(80368 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF APPLICATION SERIAL NO. 86038104
PUBLISHED IN THE OFFICIAL GAZETTE OF JANUARY 7, 2014**

COMBE INCORPORATED,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition Proceeding No. 91214779
	:	
MARKE ENTERPRISES, LLC,	:	
	:	
Applicant.	:	

**OPPOSER'S OPPOSITION TO
APPLICANT'S OPPOSITION TO ORDER TO SHOW CAUSE**

Combe Incorporated ("Opposer") submits this Opposition to Marke Enterprises, LLC's ("Applicant") Opposition to Order to Show Cause Why Judgment by Default Should Not be Entered Against Applicant in Accordance with Fed.R.Civ.P. 55(b)(2) (Applicant's Opposition").

I. PRELIMINARY STATEMENT

In order to set aside default judgment, an applicant must establish good cause as to why default judgment should not be entered against it, including, that it has a meritorious defense. All the defenses alleged by Applicant fail as a matter of law. Because Applicant has failed to put forth any meritorious defense, the relief requested by Applicant should be denied as futile.

II. BACKGROUND

A. This Opposition Proceeding

Opposer has, for many years, offered for sale and sold in commerce health and personal care products, including but not limited to, powders, creams, moisturizers, washes, towlettes/wipes, and testing/screening kits for feminine use under trademarks consisting of or containing VAGISIL. It owns at least eight trademark registrations for its VAGISIL trademarks

for various health and personal care products - U.S. Registrations No. 1104172, No. 1424503, No. 2971826, No. 3285997, No. 3696951, No. 4073832, No. 4205458, and No. 4343995 ("Opposer's Marks"). Opposer's oldest registration for VAGISIL, U.S. Registration No. 1104172, for "pharmaceutical preparations – namely, medicated crèmes", was registered on October 17, 1978, and claims a first use date of September 13, 1973. (Ex. A).

On August 14, 2013, Applicant filed a trademark application for the mark VAGISERT for "Vaginal antifungal preparations" based on an intent to use the mark in commerce ("Applicant's Mark"). (Ex. B). Applicant's Mark was published for opposition on January 7, 2014. (Id.). On February 5, 2014, Opposer timely filed its Notice of Opposition to commence this proceeding. (Doc. 1).

Applicant's answer to the Notice of Opposition was due on March 17, 2014. (Doc. 2). No answer was filed. As a result, the Board issued a Notice of Default on April 1, 2014 allowing Applicant thirty (30) days to show cause why judgment by default should not be entered against it. (Doc. 4). Applicant has not shown good cause why default judgment should not be entered against it.

B. Other Pending Opposition Proceeding Between the Parties

On March 19, 2014, Opposer filed another notice of opposition, U.S. Opposition No. 91215509, opposing registration of Applicant's VAGISERT VAGINAL APPLICATORS and design trademark, U.S. Application Serial No. 86/038,137, for "Vaginal antifungal preparations" ("Second Opposition Proceeding"). This proceeding is pending before Interlocutory Attorney Jennifer Krisp.

Applicant's answer was due on April 28, 2014. (Second Opposition Proceeding, Doc. 2). Applicant did not timely file its answer.

On May 5, 2014, Applicant's counsel contacted Opposer's counsel to seek its consent to reopen the time for Applicant to respond to the Notice of Opposition because Applicant's delay in retaining new counsel prevented it from timely answering. (Ex. C, Declaration of Robert R. Caliri ("Dec. of Caliri") ¶¶2-3). Opposer's counsel agreed, but only on those grounds. (Id. at ¶4).

On May 5, 2014, in the Second Opposition Proceeding, Applicant filed a motion entitled "Applicant's Consent Motion to Reopen Time to Respond to Notice of Opposition and Motion to Suspend Proceedings Pending Disposition of Motion." The motion argues that Applicant has meritorious defenses based on laches, acquiescence, estoppel, and "famousness". (Second Opposition Proceeding, Doc. 5, pp. 5-6). A proposed answer to the Notice of Opposition is not attached to the motion.

Applicant's Motion in the Second Opposition falsely claims that Opposer "has given its oral consent to the relief requested." (Second Opposition Proceeding, Doc. 5, p. 1). Opposer's counsel has no recollection of Applicant's counsel discussing the alleged defenses of laches, acquiescence, estoppel, and "famousness" during the conversation between the two counsel. (Ex. C, Dec. of Caliri, ¶5). Opposer's counsel did not see the motion, and has no recollection of consenting, on behalf of Opposer, to Applicant alleging these defenses as support for the requested relief. (Id. at ¶¶ 5, 6). Because of the misrepresentations made in Applicant's pending motion in the Second Opposition Proceeding and Applicant's failure to put forth any meritorious defense, Opposer has concurrently filed an opposition to Applicant's request to reopen the time for it to respond in the Second Opposition Proceeding.

III. ARGUMENT

A. Default Judgment Should Be Entered Because Applicant Does Not Have Any Meritorious Defenses

Default judgment should be entered because the four defenses offered by Applicant (1) laches, (2) acquiescence, (3) estoppel, and (4) "famousness" are not meritorious and do not constitute a complete defense to Opposer's claims. The defenses of laches, acquiescence or estoppel are generally not available in an opposition proceeding. *See Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007); *see also University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n. 39 (TTAB 1994) (equitable defenses are not grounds for opposition).

Applicant's Opposition to the Notice of Default did not comply with the instructions of Section 312.01 of the Trademark Trial and Appeal Board Manual of Procedure because it did not include an answer. Because Applicant has not answered the opposition, Applicant's Opposition is the only evidence of Applicant's allegations and defenses in response to the Notice of Opposition. Applicant's Opposition does not argue that there is no likelihood of confusion from Opposer's use of Opposer's Marks and Applicant's use of Applicant's Mark. As Applicant has for all intents and purposes conceded that confusion is inevitable, its equitable defenses of laches, acquiescence and estoppel fail as a matter of law and are not meritorious. *See Christian Broadcasting Network Inc. v. ABS-CBN Intl's*, 84 USPQ2d 1560, 1572 (TTAB 2007) (equitable defenses such as laches and acquiescence would not preclude a judgment for plaintiff if confusion is inevitable); *see also Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (it is within the public interest to have certain registrations removed from the register and this interest, quoting *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 USPQ 313, 316 (TTAB 1965), "cannot be waived by the

inaction of any single person or concern no matter how long the delay persists"), aff'd, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967); *Turner v. Hops Grill & Bar Inc.*, 53 USPQ2d 1310, 1313 (TTAB 1999) (laches will not prevent cancellation where it is determined that confusion is inevitable).

1. Applicant Does Not Have a Meritorious Laches Defense

Pursuant to 15 U.S.C. § 1069, the defense of laches requires "a showing of undue delay in asserting rights against a claimant to a conflicting mark and prejudice resulting therefrom." *Nat'l Cable Television Assoc., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1580 (Fed. Cir. 1991) (citing *Ralston Purina Co. v. Midwest Cordage Co.*, 373 F.2d 1015, 1018-19 (CCPA 1967)). "[L]aches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made." *Id.* at 1581 (citing 15 U.S.C. §§ 1065, 1072, 1115). In an opposition proceeding, laches does not begin to run until the opposed application is published for opposition. *Id.* at 1582

Applicant's Mark was published on January 7, 2014. (Ex. B). Thus, the time that Applicant's laches defense began to run was January 7, 2014. Opposer filed the instant Opposition Proceeding on February 5, 2014. (Doc. 1). Applicant has put forth no evidence or argument that Opposer unduly delayed in asserting its rights against Opposer since January 7, 2014 or that the delay since January 7, 2014 has caused Applicant to suffer any prejudice. Thus, Applicant's laches defense fails and is not meritorious.

In some instances, a laches defense can be offered in an opposition proceeding based on an opposer's failure to object to *applicant's* earlier registration of substantially the same mark for substantially the same goods. See *Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732 (Fed. Cir. 1992).

Contrary to the assertions of Applicant, U.S. Registration No. 401,202 for the mark VAGISERT for a "vaginal suppository" ("Expired VAGISERT Registration"), which expired in 1986, does not support Applicant's laches defense.

The Expired VAGISERT Registration was owned by Chicago Pharmacal Company. (Ex. D). Applicant has offered no evidence or argument that Chicago Pharmacal Company is Applicant – Marke Enterprises, LLC. Because Applicant was not the owner of the Expired VAGISERT Registration, it is not justified in relying on the existence of this non-identical expired registration to support its laches defense. *See Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156 (recognizing that a "tacking" defense applies when the prior registration and opposed application are owned by the same entity).

Additionally, based on a review of the registration certificates, Opposer could not have opposed or moved to cancel the Expired VAGISERT Registration based on a likelihood of confusion. The Expired VAGISERT Registration registered in 1943 and claimed a first use date in 1942. (Ex. D). Opposer's first registration for VAGISIL, Registration No. 1,104,172, for "pharmaceutical preparations – namely, medicated cremes" registered on October 17, 1978 and claimed a first use date of September 13, 1973. (Ex. A). According to the registrations, Opposer did not have priority and probably could not have moved to cancel the Expired VAGISERT Registration based on a likelihood of confusion.

Opposer's inability to challenge the Expired VAGISERT Registration does not give Applicant an unfettered right to attempt to adopt Applicant's Mark. It has been nearly twenty (20) years since Chicago Pharmacal abandoned its rights in the VAGISERT trademark. Since then, Opposer has exclusively used Opposer's Marks without any use of VAGISERT by others.

Opposer is entitled to assert the rights it has obtained in Opposer's Marks over at least the past twenty (20) years against others, including against Applicant.

Even assuming that Opposer delayed in challenging registration of Applicant's Mark, a fact it vehemently contests, mere delay is not enough. *See Aquion Partners L.P. v. Envirogard Products Ltd.*, 43 USPQ2d 1371, 1374 (TTAB 1997). Applicant must also show that the delay materially prejudiced Applicant – meaning Applicant relied on the delay to its detriment. *Id.* Applicant has offered no argument or evidence that Opposer's delay in opposing Applicant's intended use and registration of Applicant's Mark in January and February 2014 caused Applicant to suffer material prejudice.

Applicant's laches defense is not meritorious because it would fail as a matter of law.

2. Applicant Does Not Have a Meritorious Acquiescence Defense

In an *inter partes* proceeding, there is not a separate "acquiescence" defense. Instead "laches" is sometimes characterized as acquiescence. *See Nat'l Cable Television*, 937 F.2d at 1580. As Applicant's laches defense fails as a matter of law and is not meritorious, so does Applicant's acquiescence defense.

3. Applicant Does Not Have a Meritorious Estoppel Defense

"The elements of equitable estoppel are (1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted." *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992).

The date that is relevant to Applicant's estoppel defense is the date Applicant's Mark was published for opposition – January 7, 2014. *See Bausch & Lomb Inc. v. Karl Storz GmbH & Co.*

KG, 87 USPQ2d 1526, 1531 (TTAB 2008) ("Conduct which occurs prior to publication of the application for opposition generally cannot support a finding of equitable estoppel.") (citing *Lincoln Logs*, 971 F.2d at 734; *Nat'l Cable Television*, 937 F.2d at 1581).

Applicant does not have a meritorious estoppel defense. Opposer objected to Applicant's registration of Applicants Mark at the first opportunity it had, in February 2014. Additionally, Opposer has never, by affirmative conduct, silence or inaction, represented that Opposer would not challenge Applicant's intended use of Applicant's Mark. Applicant has not offered any evidence or argument that since January 2014 Opposer has done anything that would lead Applicant to reasonably infer that Opposer would not assert its rights in Opposer's Marks against it, that Applicant relied on Opposer's conduct or lack thereof, or that this reliance caused Applicant to suffer material prejudice. *See Lincoln Logs*, 971 F.2d at 734. Because Applicant has failed to argue or provide any evidence that would support a defense of estoppel, Applicant's equitable defense of estoppel fails as a matter of law and is not meritorious.

Applicant's attempt to use the Expired VAGISERT Registration to support its estoppel defense fails because Applicant never owned the Expired VAGISERT Registration, the Expired VAGISERT Registration is not identical for tacking purposes to Applicant's Mark, and Opposer's rights in VAGISIL predate Applicant's rights in Applicant's Mark.

Applicant's estoppel defense is not meritorious, fails as a matter of law and does not preclude entry of default judgment.

4. Applicant Does Not Have a Meritorious "Famousness" Defense

It is unclear whether Applicant's "famousness" defense alleges that Opposer's Marks are famous or that Applicant's Mark, the application for registration of which is based on an intent to use, is famous. Regardless, this defense fails as a matter of law and is not meritorious because

Applicant has offered no evidence or argument that the defense is a viable defense to a claim based on likelihood of confusion.

IV. CONCLUSION

The Board should deny the relief requested by Applicant because Applicant has failed to show good cause why default judgment should not be entered. All the defenses offered by Applicant fail as a matter of law. Because none of the defenses offered by Applicant are meritorious, vacating the default and allowing this proceeding to resume would serve no useful purpose.

WHEREFORE, Opposer, Combe Incorporated Inc., respectfully requests that the Board deny the relief requested by Applicant and enter default judgment in favor of Opposer.

Respectfully submitted,

COMBE INCORPORATED

Date: May 20, 2014

By: /Robert R. Caliri/
Robert R. Caliri
Alissa A. Digman
OLSON & CEPURITIS, LTD.
20 N. Wacker Drive, 36th Floor
Chicago, IL 60606
(312) 580-1180

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document and its attachments is being served via the United States Postal Service on the date shown below with sufficient postage prepaid as First Class Mail in an envelope addressed to:

Brian J. Jacobs
6464 Woodman Avenue, Suite 103
Van Nuys, California 91401

on this 20th day of May, 2014.

/Robert R. Caliri/

Robert R. Caliri

EXHIBIT A

Generated on: This page was generated by TSDR on 2014-03-19 10:25:46 EDT

Mark: VAGISIL

US Serial Number: 73164746

Application Filing Date: Apr. 03, 1978

US Registration Number: 1104172

Registration Date: Oct. 17, 1978

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Jul. 29, 2008

Mark Information

Mark Literal Elements: VAGISIL

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 0586869, 0979805, 0997471

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: PHARMACEUTICAL PREPARATIONS-NAMELY, MEDICATED CREMES

International Class(es): 005 - Primary Class

U.S Class(es): 018

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 13, 1973

Use in Commerce: Sep. 13, 1973

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: COMBE INCORPORATED

Owner Address: 1101 WESTCHESTER AVENUE
WHITE PLAINS, NEW YORK 106043597
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record	
Attorney Name: Robert R. Caliri	Docket Number: Report 413
Attorney Primary Email Address: rcaliri@olsonip.com	Attorney Email Authorized: No
Correspondent	
Correspondent Name/Address: Robert R. Caliri Olson & Cepuritis, Ltd. 20 North Wacker Drive 36th Floor Chicago, ILLINOIS 60606 UNITED STATES	
Phone: 312-580-1180	Fax: 312-580-1189
Correspondent e-mail: rcaliri@olsonip.com	Correspondent e-mail Authorized: No
Domestic Representative - Not Found	

Prosecution History

Date	Description	Proceeding Number
Dec. 15, 2008	ATTORNEY REVOKED AND/OR APPOINTED	
Dec. 15, 2008	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jul. 29, 2008	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	70619
Jul. 29, 2008	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jul. 29, 2008	ASSIGNED TO PARALEGAL	70619
Apr. 11, 2008	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Apr. 11, 2008	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Apr. 11, 2008	PAPER RECEIVED	
Jan. 16, 2008	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jan. 07, 2008	CASE FILE IN TICRS	
Jun. 12, 2007	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 11, 2004	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 24, 1998	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
May 07, 1998	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Feb. 28, 1985	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Oct. 16, 1984	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Oct. 17, 2008

TM Staff and Location Information

TM Staff Information - None	
File Location	
Current Location: POST REGISTRATION	Date in Location: Jul. 29, 2008

Assignment Abstract Of Title Information

Summary	
Total Assignments: 3	Registrant: COMBE INCORPORATED
Assignment 1 of 3	
Conveyance: ASSIGNS AS OF JAN. 1, 1981 THE ENTIRE INTEREST AND THE GOOD WILL	
Reel/Frame: 0479/0725	Pages: 3
Date Recorded: Oct. 16, 1984	
Supporting Documents: No Supporting Documents Available	

Assignor	
Name: COMBE INCORPORATED	Execution Date: Oct. 11, 1984
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Assignee	
Name: COMBE PRODUCTS, INC.	
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Address: 1101 WESTCHESTER AVE. WHITE PLAINS, NEW YORK 10604	
DBA, AKA, TA, Formerly: FORMERLY COMBE PUERTO RICO, INC.	
Correspondent	
Correspondent Name: EMRICH AND DITHMAR	
Correspondent Address: SUITE 3000 150 NORTH WACKER DRIVE CHICAGO, IL 60606	
Domestic Representative - Not Found	
Assignment 2 of 3	
Conveyance: MERGER	
Reel/Frame: 2283/0022	Pages: 6
Date Recorded: Apr. 19, 2001	
Supporting Documents: assignment-tm-2283-0022.pdf	
Assignor	
Name: COMBE PRODUCTS, INC.	Execution Date: May 31, 2000
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Assignee	
Name: COMBE PHARMA LTD.	
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Address: 1101 WESTCHESTER AVENUE WHITE PLAINS, NEW YORK 10604-3597	
Correspondent	
Correspondent Name: EMRICH & DITHMAR	
Correspondent Address: ROBERT R. CALIRI 300 SOUTH WACKER DRIVE SUITE 300 CHICAGO, IL 60606	
Domestic Representative - Not Found	
Assignment 3 of 3	
Conveyance: ASSIGNS THE ENTIRE INTEREST	
Reel/Frame: 3686/0181	Pages: 6
Date Recorded: Dec. 26, 2007	
Supporting Documents: assignment-tm-3686-0181.pdf	
Assignor	
Name: COMBE PHARMA LTD.	Execution Date: Dec. 20, 2007
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Assignee	
Name: COMBE INCORPORATED	
Legal Entity Type: CORPORATION	State or Country Where Organized: DELAWARE
Address: 1101 WESTCHESTER AVENUE WHITE PLAINS, NEW YORK 10604-3597	
Correspondent	
Correspondent Name: ROBERT R. CALIRI	

Correspondent Address: OLSON & CEPURITIS, LTD.
20 NORTH WACKER DRIVE
36TH FLOOR
CHICAGO, ILLINOIS 60606

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: [91214779](#)

Filing Date: Feb 05, 2014

Status: Pending

Status Date: Feb 05, 2014

Interlocutory Attorney: YONG OH (RICHARD) KIM

Defendant

Name: Marke Enterprises, LLC

Correspondent Address: Sonia F. Lakhany
LILENFELD PC
2970 PEACHTREE RD NW STE 530
ATLANTA GA , 30305-2114

Correspondent e-mail: sonia@lilenfeldpc.com; david@lilenfeldpc.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
VAGISERT	Opposition Pending	86038104	

Plaintiff(s)

Name: Combe Incorporated

Correspondent Address: Robert R. Caliri
Olson & Cepuritis, Ltd.
20 N. Wacker Dr., 36th Floor
Chicago IL , 60606
UNITED STATES

Correspondent e-mail: rcaliri@olsonip.com , adigman@olsonip.com , docket@olsonip.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
VAGISIL	Renewed	73164746	1104172
VAGISIL	Renewed	73536975	1424503
VAGISIL	Section 8 and 15 - Accepted and Acknowledged	76506165	2971826
VAGISIL	Section 8 and 15 - Accepted and Acknowledged	78852682	3285997
VAGISIL SATIN	Registered	77608036	3696951
VAGISIL	Registered	85311816	4073832
VAGISIL	Registered	85532058	4205458
VAGISIL	Registered	85622954	4343995

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 05, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 05, 2014	Mar 17, 2014
3	PENDING, INSTITUTED	Feb 05, 2014	

Type of Proceeding: Opposition

Proceeding Number: [91213510](#)

Filing Date: Nov 15, 2013

Status: Terminated

Status Date: Feb 07, 2014

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Darren J. Greco

Correspondent Address: WILLIAM D HARE
MCNEELEY HARE & WAR LLP

12 ROSZEL ROAD SUITE C104
PRINCETON NJ , 08540
UNITED STATES

Correspondent e-mail: bill@miplaw.com

Associated marks			
Mark	Application Status	Serial Number	Registration Number
VAGISSAGE	Abandoned - After Inter-Partes Decision	85790965	
Plaintiff(s)			

Name: Combe Incorporated

Correspondent Address: ROBERT R CALIRI
OLSON & CEPURITIS LTD
20 N WACKER DR, 36TH FLOOR
CHICAGO IL , 60606
UNITED STATES

Correspondent e-mail: rcaliri@olsonip.com , adigman@olsonip.com , docket@olsonip.com

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VAGISIL	Renewed	73164746	1104172
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VAGISIL	Registered	85311816	4073832
VAGISIL	Registered	85532058	4205458
VAGISIL	Registered	85622954	4343995

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 15, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 15, 2013	Dec 25, 2013
3	PENDING, INSTITUTED	Nov 15, 2013	
4	STIP FOR EXT	Dec 24, 2013	
5	EXTENSION OF TIME GRANTED	Dec 24, 2013	
6	W/DRAW OF APPLICATION W/ CONSENT	Jan 16, 2014	
7	BD DECISION: DISMISSED W/ PREJ	Feb 07, 2014	
8	TERMINATED	Feb 07, 2014	

Type of Proceeding: Opposition

Proceeding Number: [91209708](#)

Filing Date: Mar 07, 2013

Status: Pending

Status Date: Mar 07, 2013

Interlocutory Attorney: WENDY COHEN

Defendant	
Name: Dr. August Wolff; GmbH & Co. KG Arzneimi ttel	
Correspondent Address: MICHAEL J STRIKER STRIKER STRIKER & STENBY 103 E NECK RD HUNTINGTON NY , 11743-1567 UNITED STATES	
Correspondent e-mail: striker@strikerlaw.com	

Associated marks			
Mark	Application Status	Serial Number	Registration Number
VAGISAN	Opposition Pending	79111922	
Plaintiff(s)			

Name: Combe Incorporated

Correspondent Address: ROBERT R CALIRI
OLSON & CEPURITIS LTD
20 N WACKER DR, 36TH FLOOR
CHICAGO IL , 60606
UNITED STATES

Correspondent e-mail: rcaliri@olsonip.com , adigman@olsonip.com , docket@olsonip.com

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VAGISIL SATIN	Registered	77608036	3696951
VAGISIL	Registered	85311816	4073832
VAGISIL	Registered	85532058	4205458
VAGISIL THE EXPERT IN INTIMATE SKIN	Abandoned - No Statement Of Use Filed	85407329	
VAGISIL	Registered	85622954	4343995

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 07, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 12, 2013	Apr 21, 2013
3	PENDING, INSTITUTED	Mar 12, 2013	
4	STIP FOR EXT	Apr 10, 2013	
5	EXTENSION OF TIME GRANTED	Apr 10, 2013	
6	ANSWER	May 14, 2013	
7	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jun 25, 2013	
8	SUSPENDED	Jun 25, 2013	
9	STIP TO SUSP PEND SETTL NEGOTIATIONS	Dec 11, 2013	
10	SUSPENDED	Dec 11, 2013	

Int. Cl.: 5

Prior U.S. Cl.: 18

United States Patent and Trademark Office

Reg. No. 1,104,172
Registered Oct. 17, 1978

TRADEMARK
Principal Register

VAGISIL

Combe Incorporated (Delaware corporation)
1101 Westchester Ave.
White Plains, N.Y. 10604

For: PHARMACEUTICAL PREPARATIONS—
NAMELY, MEDICATED CREMES—in CLASS 5 (U.S.
CL. 18).

First use on or about Sept. 13, 1973; in commerce on
or about Sept. 13, 1973.

Owner of Reg. Nos. 586,869, 979,805, and 997,471.

Ser. No. 164,746, filed Apr. 3, 1978.

JOHN C. DEMOS, Supervisory Examiner
R. H. NEILSON, Examiner

EXHIBIT B

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Mark: VAGISERT

VAGISERT

US Serial Number: 86038104

Application Filing Date: Aug. 14, 2013

Register: Principal

Mark Type: Trademark

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Feb. 05, 2014

Publication Date: Jan. 07, 2014

Mark Information

Mark Literal Elements: VAGISERT

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Vaginal antifungal preparations

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Marke Enterprises, LLC

Owner Address: 227 Sandy Springs Place, Ste. D133
Atlanta, GEORGIA 30328
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

**State or Country Where
Organized:** GEORGIA

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

**Correspondent
Name/Address:** BRIAN J JACOBS
BRIAN J JACOBS ATTORNEY AT LAW
6464 WOODMAN AVENUE
SUITE 103
VAN NUYS, CALIFORNIA 91401
UNITED STATES

Phone: (513) 283-3372

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 30, 2014	WITHDRAWAL OF ATTORNEY GRANTED	
Apr. 30, 2014	TEAS WITHDRAWAL OF ATTORNEY RECEIVED	
Apr. 30, 2014	ATTORNEY REVOKED AND/OR APPOINTED	
Apr. 30, 2014	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Feb. 05, 2014	OPPOSITION INSTITUTED NO. 999999	214779
Feb. 05, 2014	OPPOSITION PAPERS RECEIVED AT TTAB	
Jan. 07, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jan. 07, 2014	PUBLISHED FOR OPPOSITION	
Dec. 18, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Dec. 02, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 30, 2013	ASSIGNED TO EXAMINER	74818
Oct. 17, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 23, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 17, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information	
TM Attorney: KHAN, ASMAT A	Law Office Assigned: LAW OFFICE 114
File Location	
Current Location: PUBLICATION AND ISSUE SECTION	Date in Location: Dec. 05, 2013

Proceedings

Summary
Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: 91214779	Filing Date: Feb 05, 2014
Status: Pending	Status Date: Feb 05, 2014
Interlocutory Attorney: YONG OH (RICHARD) KIM	

Defendant

Name: Marke Enterprises, LLC
Correspondent Address: BRIAN J JACOBS BRIAN J JACOBS ATTORNEY AT LAW 6464 WOODMAN AVENUE, SUITE 103 VAN NUYS CA , 91401 UNITED STATES
Correspondent e-mail: brianjacobs21@yahoo.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
VAGISERT	Opposition Pending	86038104	
Plaintiff(s)			

Name: Combe Incorporated
Correspondent Address: ROBERT R CALIRI OLSON & CEPURITIS LTD 20 NORTH WACKER DRIVE, 36TH FLOOR CHICAGO IL , 60606 UNITED STATES
Correspondent e-mail: rcaliri@olsonip.com , adigman@olsonip.com , docket@olsonip.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
VAGISIL	Renewed	73164746	1104172
VAGISIL	Renewed	73536975	1424503

VAGISIL	Section 8 and 15 - Accepted and Acknowledged	76506165	2971826
VAGISIL	Section 8 and 15 - Accepted and Acknowledged	78852682	3285997
VAGISIL SATIN	Registered	77608036	3696951
VAGISIL	Registered	85311816	4073832
VAGISIL	Registered	85532058	4205458
VAGISIL	Registered	85622954	4343995

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 05, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 05, 2014	Mar 17, 2014
3	PENDING, INSTITUTED	Feb 05, 2014	
4	NOTICE OF DEFAULT	Apr 01, 2014	
5	D RESP TO BD ORDER/INQUIRY	Apr 30, 2014	
6	D REQ TO W/DRAW AS ATTORNEY	Apr 30, 2014	

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF APPLICATION SERIAL NO. 86038104
PUBLISHED IN THE OFFICIAL GAZETTE OF JANUARY 7, 2014**

COMBE INCORPORATED,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition Proceeding No. 91214779
	:	
MARKE ENTERPRISES, LLC,	:	
	:	
Applicant.	:	

**DECLARATION OF ROBERT R. CALIRI IN SUPPORT OF OPPOSER'S OPPOSITION
TO APPLICANT'S OPPOSITION TO ORDER TO SHOW CAUSE**

I, ROBERT R. CALIRI, declare as follows:

1. I am of counsel with Olson & Cepuritis, Ltd., attorneys for Opposer Combe Incorporated ("Combe"). I am over 18 years of age and have personal knowledge of the matters included in this Declaration. I submit this Declaration in Support of Opposer's Opposition to Applicant's Opposition to Order to Show Cause filed in U.S. Opposition Proceeding No. 91214779.

2. On May 5, 2014, Brian J. Jacobs, as counsel for Marke Enterprises, LLC ("Marke"), contacted me to seek Combe's consent to reopen the time for Marke to answer the notice of opposition between the parties – U.S. Opposition No. 91215509.

3. Mr. Jacobs represented that Marke's delay in timely responding to the notice of opposition was a result of its need to obtain new counsel.

4. I, on behalf of Combe, consented to Marke moving to reopen the time for it to respond to the notice of opposition on the basis that Marke's delay in responding to the notice of opposition was a result of its need to obtain new counsel.

5. I have no recollection of Mr. Jacobs discussing Marke's defenses of laches, acquiescence, estoppel, and/or "famousness" during our conversation on May 5, 2014.

6. I did not see the motion and I have no recollection of consenting, on behalf of Combe, to Marke moving to reopen the time for it to respond to the notice of opposition on the defenses of laches, acquiescence, estoppel and/or "famousness".

I declare under penalty of perjury that the forgoing is true and correct. Executed on May 20, 2014 in Chicago, Illinois.

/Robert R. Carliri/
Robert R. Caliri

EXHIBIT D

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Mark: VAGISERT

VAGISERT

US Serial Number: 71457460

Application Filing Date: Dec. 17, 1942

US Registration Number: 401202

Registration Date: Apr. 27, 1943

Register: Principal

Mark Type: Trademark

Status: This registration was not renewed and therefore has expired.

Status Date: Jan. 10, 1986

Mark Information

Mark Literal Elements: VAGISERT

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Related Properties Information

Publish Previously Yes

Registered Mark:

Previously Registered Apr. 08, 1952

Mark Publication Date:

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *...* identify additional (new) wording in the goods/services.

For: VAGINAL SUPPOSITORY

International Class(es): 005

U.S Class(es): 018 - Primary Class

Class Status: EXPIRED

Basis: 1(a)

First Use: Nov. 04, 1942

Use in Commerce: Nov. 04, 1942

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: CHICAGO PHARMACAL COMPANY

Owner Address: CHICAGO, ILL.

Legal Entity Type: ILLINOIS.

State or Country Where Organized: No Place Where Organized Found

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

**Correspondent ?
Name/Address:**

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 10, 1986	EXPIRED SEC. 9	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: FILE DESTROYED

Date in Location: Jun. 01, 1989

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Assignment 1 of 1

Conveyance: CHANGE OF NAME 19640424

Reel/Frame: [0113/0432](#)

Pages: 4

Date Recorded: May 20, 1964

Supporting Documents: No Supporting Documents Available

Assignor

Name: [CHICAGO PHARMACAL COMPANY](#)

Execution Date: May 18, 1964

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [CONAL PHARMACEUTICALS, INC.](#)

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: No Assignee Address Found

Correspondent

Correspondent Name: ANDERSON, LUEDEKA ET AL.

Correspondent Address: 2157 FIELD BLDG.
135 S. LA SALLE ST.
CHICAGO, IL 60603

Domestic Representative - Not Found

Registered Apr. 27, 1943

Trade-Mark 401,202

Republished, under the Act of 1946, April 8, 1952, by
Chicago Pharmacal Company, Chicago, Ill., a corporation
of Illinois.

UNITED STATES PATENT OFFICE

The Chicago Pharmacal Company, Chicago, Ill.

Act of February 20, 1905

Application December 17, 1942, Serial No. 457,460

VAGISERT

STATEMENT

To all whom it may concern:

Be it known that The Chicago Pharmacal Company, a corporation duly organized under the laws of the State of Illinois and located at Chicago, Illinois, and doing business at No. 5547 Ravenswood Avenue, Chicago, Illinois, has adopted and used the trade-mark shown in the accompanying drawing, for a VAGINAL SUPPOSITORY, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five specimens or facsimiles showing the trade-mark as actually used by applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended.

The trade-mark has been continuously used and applied to said goods in applicant's business since November 4, 1942.

The trade-mark is applied or affixed to the goods, or to the packages containing the same by placing thereon a printed label on which the trade-mark is shown.

The undersigned hereby appoints Mida, Richards and Murray, a firm composed of Lee W. Mida, Brayton G. Richards and Alexander W. Murray, whose postal address is 537 S. Dearborn Street, Chicago, Illinois, its attorneys, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

**THE CHICAGO
PHARMACAL COMPANY,**
By **W. B. TAYLOR, Jr.,**
Secretary.